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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,460	03/25/2004	Toshiki Taguchi	Q80704	4866

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EXAMINER

KLEMANSKI, HELENE G

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,460

Applicant(s)

TAGUCHI ET AL.

Examiner

Helene Klemanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/25/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Claims 1 and 7 have been amended, none of the claims have been deleted and new claim 8 has been added. Hence, claims 1-8 are pending in the application.
2. In the IDS filed June 25, 2004, the examiner has inadvertently failed to place her initials next to the first two listed documents. A new copy of the IDS filed June 25, 2004 with the examiner's initials next to the first two documents is attached as requested by applicants.
3. The 112, second paragraph rejection to the claims as set forth in the previous Office Action dated January 25, 2006 has been overcome by applicant's amendments and is now withdrawn.
4. The 102(a) rejection over EP 1384762 as set forth in the previous Office Action dated January 25, 2006 has been overcome by the filing of a certified English language translation of applicant's foreign priority and is now withdrawn.
5. The 102(e) rejection over Miyamoto et al. (US 2004/0055508) as set forth in the previous Office Action dated January 25, 2006 has been overcome by the filing of a certified English language translation of applicant's foreign priority and is now withdrawn. A new 102(b) rejection is entered below.

Terminal Disclaimer

6. The terminal disclaimer filed on June 26, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of

any patent granted on Application No. 10/611,990 has been reviewed and is accepted. The terminal disclaimer has been recorded. New obviousness-type double patenting and provisional obviousness-type double patenting rejections are entered below.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 5 and 11 of U.S. Patent No. 7,083,668. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

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9. Claims 1-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4-8 and 15 of U.S. Patent No.

7,037,365. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

10. Claims 1, 7 and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 16, 17 and 20-23 of U.S. Patent No. 7,029,523. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

11. Claims 1-4, 7 and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6 and 7 of U.S. Patent No. 7,022,170. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

12. Claims 1-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5 and 10-13 of U.S. Patent No. 6,874,882. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

13. Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending

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Application No. 10/811,395 (US 2005/0004260). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4 and 7-19 of copending Application No. 10/809,954 (US 2004/0194659). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-6 of copending Application No. 10/809,550 (US 2004/0187738). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 4-8 of copending Application No. 10/808,464 (US 2004/0187736). Although the conflicting claims are not

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identical, they are not patentably distinct from each other because the claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 1, 7 and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 17 and 19-22 of copending Application No. 10/503,763 (US 2006/0092248). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18. Claims 1, 7 and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 16-20, 22 and 23 of copending Application No. 10/503,710 (US 2006/0162492). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

19. Claims 1, 7 and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8 and 10-13 of

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compending Application No. 10/502,393 (US 2005/0076807). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said compending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

20. Claims 1, 7 and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6, 16 and 17 of compending Application No. 10/502,388 (US 2005/0057629). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said compending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

In the above patents and compending Application No's. it is the examiner's position that it would have been obvious to one having ordinary skill in the art that the relation of $\epsilon_1/\epsilon_2 > 1.2$ wherein ϵ_1 represents a molar extinction coefficient obtained from absorbance at the maximum wavelength of a spectral absorption curve obtained by measuring an aqueous solution of the dye having a concentration of 0.1 mmol/liter using a cell having a light pass length of 1 cm and ϵ_2 represents a molar extinction coefficient obtained from absorbance at the maximum wavelength of a spectral absorption curve obtained by measuring an aqueous solution of the dye having a concentration of 0.2

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mmol/liter using a cell having a light pass length of 5 μ m since the dyes of above patents and copending Application No's. are the same structure as those claimed (and disclosed) by applicants.

Claim Rejections - 35 USC § 102

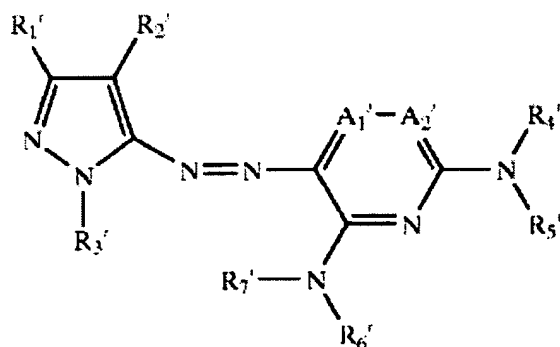
21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

22. Claims 1-4, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/083662.

WO 02/083662 teaches an ink jet ink composition comprising an aqueous medium and an azo dye of the formula



wherein R₁' represents H, an alkyl group, a cycloalkyl group, an aralkyl group, an aryl group, a heterocyclic group or an acyl group wherein each group may have a substituent; R₂' represents H, a halogen atom or a cyano group; R₃' represents H, an

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alkyl group, a cycloalkyl group, an aralkyl group, an alkenyl group, an aryl group, a heterocyclic group, a carboxyl group or a sulfo group wherein each group may have a substituent; R_4' , R_5' , R_6' and R_7' each represent H, an alkyl group, a cycloalkyl group, an aralkyl group, an alkenyl group, an aryl group, a heterocyclic group, a sulfonyl group, an acyl group, a carboxyl group, a sulfo group or a carbamoyl group wherein each group may have a substituent, provided that R_4' and R_5' do not simultaneously represent H and that R_6' and R_7' do not simultaneously represent H; A_1' and A_2' each represent $-CR=$ or a nitrogen atom provided that A_1' and A_2' do not simultaneously represent a nitrogen atom and R represents H or a substituent. The above ink jet ink is used to form monochromatic images but may also be use to form full color images together with magenta, cyan, yellow and black ink jet ink compositions. WO 02/083662 further teaches a process for printing comprising ejecting the above ink jet ink composition onto a substrate. See page 6, lines 19-22, page 7, line 13 – page 8, line 10, page 20, lines 1-18, page 22, lines 18-21, Tables 1-9, page 43, lines 1-4 and lines 21-23, page 50, lines 10-19, examples 1-6, Tables 13-16 and claims 1 and 3-8. The ink jet ink composition as taught by WO 02/083662 appears to anticipate the present claims.

The only limitation in the claims not found by the examiner is the relation of $\epsilon_1/\epsilon_2 > 1.2$ wherein ϵ_1 represents a molar extinction coefficient obtained from absorbance at the maximum wavelength of a spectral absorption curve obtained by measuring an aqueous solution of the dye having a concentration of 0.1 mmol/liter using a cell having a light pass length of 1 cm and ϵ_2 represents a molar extinction coefficient obtained from absorbance at the maximum wavelength of a spectral absorption curve obtained

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by measuring an aqueous solution of the dye having a concentration of 0.2 mmol/liter using a cell having a light pass length of 5 μm . However, this limitation is considered inherent because there does not appear to be any reason why the above cited reference would not contain a dye with applicants claimed relation since the dyes of the above references are the same structure as those claimed (and disclosed) by applicants.

Response to Arguments

23. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Helene Klemanski
Primary Examiner
Art Unit 1755



HK
September 5, 2006